REMARKS

The Examiner has rejected the currently pending claims as being "obvious" in view of the combined teachings of three patents, Schwartz (U.S. Patent No. 3,256,428) in view of Tabor (U.S. Patent No. 5,386,351) and further in view of Donaldson (U.S. Patent No. 6,070,990). As a matter of Patent Law, before the Examiner can combine three references together to make out an obviousness rejection, he must first show that there is some motivation in the prior art to combine the references. *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements.").

It is not enough for the Examiner to (1) look for the various individual components that make up a patented device in the prior art and then (2) combine them together because the patent application says to combine them. Rather, there must already be some teaching or motivation in the prior art, separate and apart from what is shown in the patent application itself, to combine those components. In other words, ***hindsight reconstruction*** based on the applicant's own disclosure is not permitted. *Crown Operations Int'l. v. Krone*, 289 F.3d 1367, 1376 ("Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." [emphasis added]). Indeed, if hindsight reconstruction were permitted, then practically every invention would be obvious. *See Ruiz v. A.B.*

Chance Co., 234 F.3d 654, 665 (Fed. Cir. 2000) ("Because there is 'a general rule that [patentable] combination claims can consist of combinations of old elements as well as new elements,' [] 'the notion . . . that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103.'" [emphasis added, internal citations omitted]).

It is respectfully submitted that the Examiner's rejection of the currently pending claims is not proper because, for example, he has done nothing other than grouping together cherry-picked portions of the three references at issue. Significantly, the Examiner has not provided any evidence that is purportedly is proper to combine the three references in the manner asserted. Without providing such an evidentiary basis, it is respectfully submitted that, in making the rejection, the Examiner is relying on the teachings of the subject application to make the combination, which is improper hindsight reconstruction. For this reason, for example, the Examiner is respectfully requested to withdraw the obviousness rejection.

It is respectfully submitted that the new claims are in condition for allowance and, therefore, a formal notice to that effect is earnestly solicited. In this regard, the Examiner is respectfully requested to contact the undersigned attorney upon entry of this amendment.

Respectfully submitted,

December 12, 2005
WELSH & KATZ, LTD.
120 South Riverside Plaza, 22nd Floor
Chicago, Illinois 60606
Telephone: (312) 655-1500
Facsimile: (312) 655-1501

Jeffrey W. Salmon
Reg. No. 37,435
Attorney for Applicant

December 12, 2005

WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500

CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING SENT TODAY TO FACSIMILE MACHINE FOR GROUP 2875, THE FACSIMILE NUMBER OF WHICH IS 571-273-8300.

Jeffrey W. Salmon

December 12, 2005
DATE